

REMARKS

A Request for Continued Examination and the requisite fee accompany this paper to remove the finality of the pending Office Action and to obtain consideration of the new claims presented herein.

Claims 1-19 were pending in the application. Upon entry of this Response, claims 20-29 will be presented for examination, claims 1-19 having been canceled herein and new claims 20-29 added.

The Examiner applied a rejection under 35 USC § 101 to some of the claims that have been canceled, but the claims currently presented are believed to clearly recite statutory subject matter. In particular, claim 20 recites, among other limitations, “receiving at a computer a report from outside counsel”. Thus the invention of claim 20 applies, involves and uses the technological arts. Moreover, claims 24 and 26 recite certain “computer readable program code means” and claim 28 is directed to a “computer system”. Thus, each of claims 20, 24, 26 and 28, which are all of the independent claims now presented, recites statutory subject matter.

The previously presented set of claims was also rejected under 35 USC § 103(a), primarily on the basis of an asserted combination of the Heckman and Martin patents and the CPR reference. The claims now presented are believed to be allowable over these references, whether considered alone or in combination, as well as the other prior art of record.

Claim 20 is directed to a “method” which includes “receiving at a computer a report from outside counsel”, “identifying a business practice to which the report is relevant”, “evaluating the report relative to the business practice to determine whether the report is indicative of a risk of litigation”, “determining that the business practice presents a significant risk of litigation” and “issuing an alert that identifies the business practice as a significant risk of litigation”.

The Heckman patent discloses a computer-based litigation management system in which a case management strategy is planned on the basis of a template that reflects “best practices” employed in previous cases. The Martin patent discloses a method for deciding whether to make a loan using an intangible asset such as intellectual property as collateral. The CPR reference

generally discusses the desirability of using alternative dispute resolution (ADR) processes in place of litigation.

It is believed that these references, whether taken alone or in combination (assuming for the sake of argument that the references can properly be combined), fail to teach or suggest at least the following limitations of claim 24: identifying a business practice to which a report from outside counsel is relevant, evaluating the report relative to the business practice to determine whether the report is indicative of a risk of litigation, determining that the business practice presents a significant risk of litigation, and issuing an alert that identifies the business practice as a significant risk of litigation.

For example, the Heckman reference, being primarily concerned with planning and execution of a case management strategy, is not particularly relevant to identification of a business practice as a significant risk of litigation.

In its most nearly relevant teaching, the Martin reference discusses determining a degree of litigation risk relative to an item of intellectual property to determine whether the item of intellectual property is suitable to be collateral for a loan. This is completely different from identifying a business practice as a litigation risk.

Finally, the discussion of ADR in the CPR reference is essentially irrelevant to identification of a business practice as a litigation risk.

Claim 20 is believed to be allowable over these references, and over the other prior art of record, which, at least, does not teach or suggest identifying a business practice as a litigation risk.

Claims 21-23 are directly or indirectly dependent on claim 20 and are believed to be allowable at least for the reasons given above with respect to claim 20.

Claim 24 is directed to an "article of manufacture" which includes "a computer usable medium having computer readable program code means embodied therein", where the computer readable program code means includes "computer readable program code means for receiving a report from outside counsel" and "computer readable program code means for logging an alert in a database". Claim 24 further recites that the alert logged in the database identifies a business practice as a significant risk of litigation, and that the report received from outside counsel has

been evaluated relative to the business practice to determine whether the report is indicative of a risk of litigation.

As noted before, none of the references primarily relied upon by the Examiner teaches or suggests, or is even particularly relevant to, identifying a business practice as a significant risk of litigation. Neither are the other references of record particularly relevant to claim 24.

Accordingly, claim 24 is believed to be allowable, as is its dependent claim 25.

For present purposes, claim 26 is similar to claim 24, and the points made above with respect to claim 24 are applicable as well to claim 26 and its dependent claim 27.

Claim 28 is directed to a “computer system” that is programmed to: “receive a report from outside counsel” and “log an alert in a database”. Claim 28 further recites that the alert logged in the database identifies a business practice as a significant risk of litigation, and that the report received from outside counsel has been evaluated relative to the business practice to determine whether the report is indicative of a risk of litigation.

Again, the references primarily relied upon by the Examiner, and also the other references of record, are not particularly relevant to identifying a business practice as a significant risk of litigation. Therefore, claim 28 and its dependent claim 29 are believed to be allowable.

Conclusion

Accordingly, Applicants respectfully request allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the

present application, the Examiner is kindly invited to contact the undersigned via telephone at
(203) 972-3460.

Respectfully submitted,

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Date



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